

### **REMARKS**

Claims 1, 4-9, 12-20, 22-25, 27-29, and 31-33, and 37 are pending in this Application. By this Amendment, claims 1, 16, 24, and 37 have been amended and claims 2-3, 26, and 36 have been canceled. No new matter is added. These claim amendments are fully supported at least by page 18, lines 1-4, page 19, lines 12-20, and page 20, lines 1-10 of the present application. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

#### **I. Claim Objections**

Claim 12 is objected to for informalities as depending from a canceled claim and lacking antecedent basis for "the catalog printer." However, the Applicant notes that claim 12 depends from claim 1, which has not been canceled. Furthermore, claim 12 recites "a catalog printer" in lines 1-2 that provides antecedent basis for "the catalog printer" in lines 3 and 4. Therefore, the Applicant respectfully requests the withdrawal of this objection.

#### **II. Rejection under 35 U.S.C. §112, First and Second Paragraphs**

The Office Action rejects claims 1-9, 12-20, 22-29, 31-33, and 36-37 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and under 35 U.S.C. § 112, second paragraph as being indefinite. The Applicants note that claims 1, 16, and 24, have been amended responsive to the rejection, without prejudice to or disclaimer of the subject matter contained therein.

Thus, the Applicant submits that claims 1-9, 11-20, and 22-29, 31-33, and 36-37 comply with the written description and definiteness requirements. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. §112, first paragraph and second paragraph.

#### **III. Claims Define Patentable Subject Matter**

The Office Action rejects claims 1-9, 12-14, 16-20, 24, 25, 27-29, 31-33, 36, and 37 under 35 U.S.C. §103(a) as being unpatentable over Warnock (U.S. Patent No. 5,634,064) in view of Tsuchiya (U.S. Patent No. 5,239,665). Claims 15, 22, 23, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Warnock in view of Tsuchiya and further in view of Examiner's Official Notice. It is noted that claims 1, 16, 24, and 37 have been amended and claims 2-3, 26, and 36 have been canceled. To the extent these rejections remain applicable to the claims, the Applicant respectfully traverses these rejections as follows.

**A. Independent Claim 1**

Regarding amended claim 1, the Applicant submits that Warnock and Tsuchiya, either individually or in combination, fail to disclose or suggest a system for accessing electronic books including at least the combination of a viewer having a memory that stores a selected electronic book in encrypted and compressed form, wherein the viewer includes a secure microprocessor for decrypting and decompressing the encrypted and compressed electronic book only at the time of display.

Thus, for at least this reason, the Applicant submits that amended claim 1 is allowable over the cited references. As claim 1 is allowable, the Applicant submits that claims 4-9, 12, 14-15, 31-32, and 37, which depend from allowable claim 1, are therefore also allowable.

**B. Independent Claim 13**

Regarding claim 13, the Applicant asserts that Warnock and Tsuchiya, either individually or in combination, fail to disclose or suggest a system for accessing electronic books including at least the combination of a catalog printer connected to a file server for storing books, wherein the catalog printer is capable of printing information about the electronic books stored on the file server, wherein the

electronic books have encoded text, and wherein the catalog printer cannot access the encoded text, as recited in claim 13.

Warnock discloses an electronic document viewer including a digital computer system and an electronic document stored in the memory of the computer system, wherein a printer can be used for displaying a document. Warnock, however, does not disclose or suggest at least a catalog printer that prints information about electronic books and cannot access the encoded text of electronic books, as recited in claim 13. Instead, the attached printer in Warnock prints the encoded text.

The Office Action cites Antelman as disclosing an electronic library and providing an electronic catalog stating that this "is a step ahead from an actual printed copy of the catalog." The Office Action states that it is obvious to have a printer capable of printing a desired portion of any printable portion of a document.

However, claim 13 is directed to a catalog printer connected to a file server that "is capable of printing information about electronic books stored on the file server, wherein the electronic books have encoded text and wherein the catalog printer cannot access the encoded text." This provides a security feature that is not disclosed or suggested by the cited art.

Antelman does not disclose a printer at all, and does not disclose a security feature allowing hard copies of information about electronic books to be generated, yet protecting access to the actual electronic books.

Tsuchiya, in combination with Warnock and the teachings of Antelman, as cited by the Examiner, also fails to disclose at least the combination of features recited in claim 13, and therefore, fails to make up for the deficiencies of Warnock. Thus, for at least this reason, the Applicant submits that claim 13 is allowable over the cited references.

**C. Independent Claims 16 and 24**

Regarding claims 16, and 24, the Applicant submits that Tsuchiya and Warnock, either individually or in combination, fail to disclose or suggest a system for viewing electronic books retrieved from a file server comprising at least the combination of means for selecting an electronic book from the file server; a memory that stores the selected electronic book; and a storage feature providing an option to a system operator for the selected electronic book to be stored in the memory: until the electronic book is read once, wherein the electronic book is automatically erased after being read once; until a predetermined period of time has passed, wherein the electronic book is automatically erased after the predetermined period of time has passed; and permanently, wherein the electronic book is not automatically erased, as recited in claim 16 and similarly recited in claim 24.

Thus, for at least the above reasons, the Applicant submits that claims 16 and 24 are allowable over the cited references. As claims 16 and 24 are allowable, the Applicant submits that claims 17-20, 22-23, 25, 27-29, and 33, which depend from allowable claims 16, and 24, respectively, are likewise allowable for at least the above noted reasons and for the additional subject matter recited therein.

**IV. Conclusion**

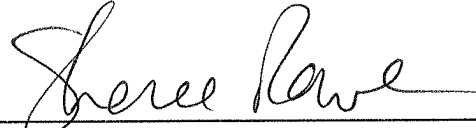
In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number set forth below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. Any fees for such an

extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026880-00021.

Respectfully submitted,

A handwritten signature in cursive script, reading "Sherree Rowe", written in black ink. The signature is positioned above a horizontal line.

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